APPENDIX I

The Constitutional Provision

ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and *useful arts,* by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. [Emphasis added.]

The Statutory Provisions

Title 35 United States Code—

§ 100. *Definitions*

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a *new use* of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee. July 19, 1952, c. 950 § 1, 66 Stat. 797. [Emphasis added.]

§ 101. *Inventions patentable*

Whoever invents or discovers any new and *useful process,* machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. July 19, 1952, c. 950, § 1, 66 Stat. 797. [Emphasis added.]

§ 102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless—

• • •

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1952, c. 950, § 1, 66 Stat. 797.

§ 112. *Specification*

The specification shall contain a written description of the invention, and of the manner and *process of* making and *using it,* in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, *to* make and *use the same,* and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. July 19, 1952, c. 950, § 1, 66 Stat. 798. [Emphasis added.]

APPENDIX II

Opinion

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

OCTOBER TERM, 1965

Interference No. 91,447

Patent Appeal No. 7415

JOHN C. KRANTZ, JR. and LOUISE SPEERS CROIX, *Appellants,*

v.

JOHN F. OLIN, *Appellee.*

March 10, 1966

RICH, Judge.

This appeal is from the decision of the Board of Patent Interferences awarding priority to appellee Olin, the senior party, in interference No. 91,447 between Krantz et al. application serial No. 657,482, filed May 7, 1957, for "Pharmaceutical Agent," and Olin application serial No. 37,035, filed June 20, 1960, for "Chemical Product," a continuation of application serial No. 556,056, filed December 29, 1955.

The Krantz et al. application is assigned to Air Reduction Company, Inc., of New York. Pennsalt Chemicals Corporation, of Pennsylvania, is assignee of the Olin applications.

In declaring the interference the examiner accorded Olin the benefit of the filing date of his earlier application, thereby making him senior party.

The sole count, which originated as claim 15 of the Krantz et al. application and was suggested by the examiner to Olin for the purpose of contesting priority, reads:

> A process which comprises reacting 2,2,2-trifluoroethyl p-toluene sulfonate with an alkali metal 2,2,2-

trifluoroethanolate and obtaining 2,2,2,2′,2′,2′-hexafluorodiethyl ether as a product therefrom.[1]

In the proceedings below, the parties filed a stipulation of facts and stipulated testimony in lieu of taking testimony. They also filed briefs and were represented at final hearing.

Part of the board's decision was that Olin, on the facts stipulated, did not have an *actual* reduction to practice and that he was not entitled to an award of priority on that basis. That issue is not before us because it was not raised on appeal by either party. With respect to it we wish it to be clearly understood that our decision herein is not to be taken as an approval of that holding or of the reasons given in the board's opinion in support thereof.

The board's award of priority to Olin was on the ground that he had a *constructive* reduction to practice of the process of the count as of the date of his parent application, December 29, 1955, prior to the filing date of Krantz et al., May 7, 1957, the board further holding that all of the proofs of Krantz et al. for an actual reduction to practice were subsequent to Olin's effective filing date. Since Krantz et al. expressly approve the last-mentioned finding of the board, it is not before us and, again, it is to be understood that this decision is not to be taken as an approval of it or the reasons in support of it.

The issue on appeal is a narrow one. As Olin states it, it is simply whether he constructively reduced to practice

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[1] This product, the patentability of which is still in dispute so far as the record shows, has been approved by the Federal Food and Drug Administration and is now marketed under the trademark "Indoklon." It has been found to be a "potent convulsant" and is used in the treatment of mental illness. A motion by appellants to add a count directed to this compound was denied. Its simple formula is: CF_3-CH_2-O-CH_2-CF_3. It is also known as bis(2,2,2-trifluoroethyl) ether and so referred to by Olin.

by filing his parent application. Krantz et al. say that the decision of the board "is clear and correct in every material respect save one:—the Board erred in holding that the parent Olin case * * * is (was) a complete and allowable application and that Olin is entitled to the 1955 filing date of his said parent application, for a constructive reduction to practice of the count."

Appellants' attack on Olin's applications is based on three main contentions: (1) that Olin intentionally included categorical disclosures or statements of utility for the compound produced by the claimed process and that these statements have been shown during the interference "to be in at least material part incorrect and misleading," (2) that Olin excluded or omitted information known to him at the time of filing which has been shown "to be of great importance to the proper and safe practice of the claimed new process and of the disclosed uses of the new compound produced thereby," and (3) that Olin has failed "to remove from the application the said misleading statements or to include or attempt to include therein the said omitted information." As may be seen, point (3) is somewhat repetitive of points (1) and (2).

Appellants carefully point out that the issue, in their opinion, is whether under these circumstances the Olin parent application can properly be considered complete and allowable,[2] and thus constitute a constructive reduction to practice of the process invention of the count.

Olin's applications both say (bracketed numbers inserted):

> The resulting new chemical compound of my invention, bis(2,2,2-trifluoroethyl) ether, is a colorless liquid which vaporizes readily at ordinary temperatures and

[2] Whether this issue is ancillary to priority is itself a potential issue (see *Glass* v. *DeRoo*, 44 CCPA 723, 239 F. 2d 402, 112 USPQ 62), but will not be considered since it has not been raised.

> [1] has useful solvent properties. For example, it may be used to prepare pastes or dispersions of high molecular weight fluorine compounds such as fluorocarbon waxes. [2]It also may be used to soften or solubilize polymeric materials, e.g., synthetic fibers. [3] It is chemically reactive and may be used in the preparation of other fluorinated compounds.

This passage, particularly the three numberod portions, constitutes all of the positive disclosure upon which appellants' objections are based.

As to disclosure [1], appellants contend the evidence shows that Olin, at the time of filing, had no experimental basis for such assertion and that, while his "guess" turned out to be correct as shown by the Neeley and Wamser affidavits introduced by appellants, one wishing to prepare the new compound and use it should first be informed of the following "caution" Olin had received from his pharmacologist Latven: "Thus it is apparent that this compound is extremely toxic and is absorbed systemically within seconds following inhalation. WE URGE YOU TO TAKE EVERY PRECAUTION IN HANDLING THIS MATERIAL AND TO AVOID ACCIDENTAL INHALATION AT ALL COSTS. You can imagine what might happen if the glass container were accidentally dropped and broken on the laboratory floor." Absent such information, say appellants, Olin's teaching of the use of the new chemical as a solvent to form a paste or dispersion is "misleading to the ordinary chemist who might attempt to follow the teaching of Olin according to the ordinary and normal meaning of the words and statements used in the Olin application."

As to disclosure [2], appellants point to evidence showing they tried the new compound with a number of synthetic fibers and found it would not soften or solubilize polystyrene, "Nylon," "Mylar," "Orlon," "Dacron," "Acrilan," and "Dynel," but that it did soften or swell

polyethylene and cellulose acetate "to some extent." Polyvinylidene chloride was "slightly soluble" anl polymethacrylate was said to be the only one "significantly soluble." Olin testified that he never tested or used the new compound to soften or solubilize a synthetic material.

As to disclosure [3], again Olin testified that he had never chemically reacted the new compound. Appellants' "experts" Wamser and Neeley found it to be "extremely stable."

The Board's response to appellants' position was:

> We cannot agree with Krantz *et al's.* position that the subject matter of the Olin applications is dangerous to the public and for that reason cannot serve as constructive reductions to practice. The record is decidedly to the contrary. It shows that the compound was safely handled while it was being prepared, and used for experimental and testing purposes. * * * It is, therefore, unnecessary to explore this aspect of the case in any great depth. There is of record pages 7 to 23 of The Handbook of Solvents, Scheflan and Jacobs, Tab 29, which are devoted to "Safe Practices in the Use of Solvents." On page 22, examples of labeling "dangerous" solvents, recommended by the Manufacturing Chemists Association, are given. The handbook article shows that a good many solvents are more or less hazardous to use, but this fact alone does not prevent their use.
>
> A similar situation exists in the case of drugs where the question of safety in humans was raised by the Patent Office. The Court of Customs and Patent Appeals has expressed its views regarding this subject. In In re Krimmel, 48 CCPA 1116, 292 F. 2d 948, 773 O.G. 607, 130 USPQ 215, 220, the Court said:
>
> . . . the fact remains that the Patent Office has not been charged by Congress with the tasks of protect-

ing the public against possible misuse of chemical patents [materials].

And in In re Hartop, 50 CCPA 780, 311 F. 2d 249, 787 O.G. 235, 135 USPQ 419, 428, the Court, after an extended discussion of "safety" reiterated its position as set forth in its earlier decision, In re Krimmel, supra.

In short we fail to find any substance in the "safety" argument pressed by Krantz *et al.*

Nor do we agree with Krantz *et al's.* contention that the Olin applications are not constructive reductions to practice because Olin did not test for any of the utilities set forth in his applications. * * *

The difficulty with Krantz *et al's.* position is that Speers, Krantz's co-inventor, did make pastes or dispersions of fluorocarbon waxes as set forth in the Olin applications; * * *. As stated in Robinson On Patents, (1890), Vol. 1, page 464, "When actual utility exists, its degree is unimportant." On page 466 of the same work, "a patent is valid if the invention serves any use though it will not apply to all uses claimed for it;" see Phillips v. Risser (1885) 26 F.R. 308. In Landon v. Ginzton, *et al.*, 41 CCPA 950, 214 F. 2d 160, 688 O.G. 213, 102 USPQ 230, 233, the Court said:

> The patent application may reveal a number of purposes for the same invention. The inventor need prove only one practical use; only one useful result or effect.

* * * See also Friedman v. Overseas Scientific Corporation *et al.* (CA-2), 248 F. 2d 274, 115 USPQ 42, 44, wherein it was held:

> An article invented may have patentable utility even though the patented device is not unfailingly operable in all its applications. Hildreth v. Mastoras, 257 U.S. 27.

Since there is proof of one of the disclosed utilities, it is unnecessary to reach the other uses set forth in the Olin specification.

Krantz *et al.* also contend that the Olin applications should contain a warning of the danger to people of the ether. We are not impressed by this argument. The specification is addressed to persons skilled in the art. Moreover, the "safety" aspect of the case has been discussed above and need not be repeated.

Krantz *et al's.* contention that the Olin applications are not constructive reductions to practice because Olin "guessed" at the disclosed utilities must be rejected. The answer to this argument is supplied by the case Automatic Weighing Machine Co. v. Pneumatic Scale Corp. Ltd. (CCA-1), 166 Fed. Rep. 288, 1909 C.D. 498, 506, 507. The Court, in that case, referred to the Supreme Court holding in the Telephone Cases, 126 U.S. 1535, 1888 C.D. 321. There, when Bell applied for his patent he had never actually transmitted, telegraphically, spoken words so that they could be distinctly heard and understood at the receiving end of his line. But in his specification he described with sufficient precision to enable one of ordinary skill in such matters to make an apparatus, which, if used in the way pointed out, would produce the required effect, receive the words, and carry them to and deliver them at the appointed place.

The Supreme Court said in that case:

> The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation.

Clearly, Olin has complied with the law as set forth in the foregoing excerpt. The record shows that Speers produced pastes and solutions of fluorocarbon waxes, as pointed out above. Therefore, it is our view that the Olin cases are complete and allowable applications and that Olin is entitled to the filing date of his parent application, namely, December 29, 1955, for a constructive reduction to practice of the count; the Automatic Weighing Machine case, supra.

We agree with the foregoing reasoning of the board in disposing of appellants' arguments. That being so, we do not accept appellants' contention that a decision in their favor is compelled by *In re Citron*, 51 CCPA 852, 325 F. 2d 248, 139 USPQ 516, the case alleged to be closest in point. That case is entirely distinguishable on the facts, for the application there asserted a use of "much public importance," namely the effective treatment of cancer, which assertion was believed to be incredible in light of the knowledge of the art. Nothing to the contrary being shown, we affirmed the rejection in *Citron* of all claims, regardless of type. Here, asserted utilities have been shown to exist.

Appellants suggested at argument that we should apply the law of contracts as set forth in 17 C.J.S. 155, note 48, to the effect that while there may be no obligation to disclose a fact, such as a particular utility of a compound made by a process, if it *is* disclosed in an application the *whole* truth about it must be told, such as the toxicity of a material alleged to be useful as a solvent. We would suggest that this is not a contract case and that an applicant for a patent, notwithstanding the popular myth that a patent is a contract, is not negotiating a contract with the Government. Rather, he is applying for a grant in accordance with a statute under which the right to a patent depends on compliance with the statutory terms and conditions. The prosecution of an application is not bargaining but a process of demonstration and persuasion that the

statute has been complied with. The examiner was persuaded that Olin had complied and the Board of Patent Interferences was not persuaded to the contrary by Krantz et al. Nor are we.

The decision of the board is *affirmed.*

AFFIRMED

WORLEY, C. J., concurs in the result.

SMITH, Judge, concurring, with whom MARTIN, Judge, joins.

The weakness of appellants' case is manifest. They conceived the invention in issue subsequent to appellee and filed their patent application subsequent to appellee's parent application. Appellants' proofs of an asserted actual reduction to practice establish a date subsequent to the date of appellee's constructive reduction to practice.

While appellee failed to prove an actual reduction to practice to the board's satisfaction, priority of the invention was awarded on the basis of appellee being the first to establish a constructive reduction to practice. To prevail here, appellants must establish that appellee was improperly given the benefit of the earlier filing date of a parent application. They seek to do so by asserting that appellee's applications

> *can not,* under the applicable law, be taken or regarded as complete and allowable applications and that Olin is *not* entitled to the filing date of his parent application * * * for a constructive reduction to practice of the count.

The *theory* of appellants' case is that if it can be shown that Olin did not file "complete and allowable" applications, appellee is not entitled to rely upon them to establish a constructive reduction to practice. In this case appellants, by reason of their filing date, would then be entitled to the award of priority. The *arguments* urged and

authorities cited in support of appellants' *theory* are confused and I do not find them to be persuasive.

Appellants assert that appellee's applications are not "complete and allowable" essentially for two reasons: (1), Olin did not disclose in his application that the product made by the process defined by the count was "dangerous" because of its usefulness as a convulsant agent;[1] and (2) while the count relates to a process, Olin did not actually make the products which he stated in his specification could be prepared from the product of the process.

As authority for the proposition that appellee failed to file a "complete and allowable" application, appellants cite 35 USC 112, 35 USC 282, and *Union Carbide & Carbon Corp.* v. *Stuart Laboratories, Inc.*, 194 F. 2d 823, 92 USPQ 262 (3rd Cir. 1952). These authorities will be considered individually.

First, considering 35 USC 112, appellants argue that *because* appellee failed to disclose that the product made by the process was useful as a convulsant, *it follows* that the disclosure failed to set forth, "in such full, clear, con-

[1] This is the apparent source of conflict between the parties. Olin's agent stated in a report dated August 29, 1955 that "violent clonic convulsions appeared in the mice within twenty (20) seconds," after inhaling the product made by the process. Olin's agent testified that this was "opposite to what was anticipated." Olin testified that he had expected the product would be "an anesthetic of low toxicity." Olin filed an application disclosing the product and the process. He did not disclose or claim use of the product as a convulsant. Krantz also conducted experiments with mice in January, 1956, and discovered the convulsant properties of the product. They then conducted experiments with humans beginning in September, 1956, and finally filed an application disclosing and claiming the process, the product made by the process and the use of the product as a convulsant agent. The record shows that the Patent Office, prior to the interference, considered the product to be unpatentable over the prior art and refused to add a count, upon appellants' motion, defining the product, to this interference.

cise, and exact terms as to enable any person skilled in the art" to "make and use" *the process.* I fail to understand the relationship between such cause and effect reasoning. Appellants admit that the appellee's disclosure does teach one of ordinary skill in the art how to practice the process defined by the count. It seems to me, therefore, that this satisfies the terms of section 112. *Swain et al.* v. *Crittendon,* 51 CCPA 1459, 332 F. 2d 820, 141 USPQ 811.

Appellants' reliance on section 112 is unfounded for another reason. The board in its opinion found that appellee's right to the filing date of his parent application was "not in dispute here." That is to say, appellee is entitled under 35 USC 120 to rely on the filing date of his parent application. This would seem to be tantamount to a finding that the terms of 35 USC 112 were satisfied by the parent application. See *Swain,* supra. I am unable to understand how appellants can consistently concede that section 120 is satisfied and yet argue that section 112 has not been complied with.

As the majority opinion notes, we are first required to assume that the matters raised by appellants are ancillary to priority. I would add that we are also asked to assume that while the conditions of 35 USC 120 have been met by appellee, we are expected to go further and decide whether appellee's parent application was "complete and allowable" as filed, for alleged failure to comply with 35 USC 112. The Patent Office has not raised any question about the compliance of appellee's parent application with the conditions of section 112. It seems to me on the present record that appellee's parent application complies with section 112 and that appellee was properly permitted to rely upon its filing date as appellee's date of a constructive reduction to practice.

Appellants also allege, without setting forth any explanation or reasoning, that the terms of 35 USC 282 have not been complied with. Independent investigation reveals

that section 282 provides as a defense in an infringement suit the "invalidity of the patent * * * on any ground specified in part II of this title [Patentability of inventions and grant of patents] as a condition for patentability," and "invalidity of the patent * * * for failure to comply with any requirements of sections 112 or 251 [Reissue of defective patents] of this title." I am at a loss to see how these sections aid appellants in establishing that appellee's parent application as filed was incomplete. It seems to me that appellants' unsupported and broad allegation that Part II of Title 35 (35 USC 100-188), has not been complied with, is insufficient as a matter of law to warrant consideration.

Finally, appellants cite *Union Carbide,* supra. In that case the question was whether the description of the process in the patent was sufficient to enable a person skilled in that art to practice the invention. The court generalized broadly that where "the patentee omitted elements which he knew were important, fraud will be implied by the fact finder." 92 USPQ at 265. The defendants had argued that the invention would have worked *better* if the patentee had disclosed certain procedural steps which, admittedly, at the time of the filing of the application were of questionable value. The court also generalized that a patentee must disclose "the whole truth relative to their invention." The court affirmed the judgment of the trial court which found the patent valid and infringed.

Broad generalizations drawn from prior decisions solve few problems and often are cited incorrectly for propositions which they do not support. The issue in dispute in *Union Carbide* was whether the terms of 35 USC 112 had been satisfied. As we have previously noted, appellants concede this issue here. Thus appellants' reliance on *Union Carbide* seems to have been misplaced.

The theory of appellants' arguments appears to have been extracted from the following statement concerning

Constructive Reduction to Practice to be found in Rivise & Caesar, Interference Law & Practice, Vol. 1, Sec. 158, at p. 497. It is there stated:

> The third prerequisite [for an applicant to be entitled to rely upon the filing date of a patent application for his reduction to practice] is that the application relied upon for a constructive reduction to practice must be one that could result in a valid patent if *prosecuted to final allowance.*

Appellants, while footnoting the above statement with no particular emphasis, argue that the alleged deficiencies they have "found" in appellee's application are uncontroverted proof that appellee's application, if prosecuted to final allowance, could not result in a valid patent. The statement from Rivise & Caesar and appellants' reliance thereon is not supported by reference to any statutory provision or by case law. Rivise & Caesar refers the reader to section 13 in which the authors discuss and cite cases concerned with the alteration of an application after execution. This area of law was extensively reviewed by Judge Rich in *Vandenberg* v. *Reynolds,* 44 CCPA 873, 242 F. 2d 761, 113 USPQ 275. Therein it was determined that the junior party was entitled to attack the sufficiency of the senior party's application as filed, on the grounds that it had been altered after execution, where the senior party relied on the filing date of the thus altered application as a constructive reduction to practice. It was there reasoned that a *decision on priority* rested on the sufficiency of the application as filed and the critical question raised, based on the allegations, was whether the application was void ab initio. An application burdened with such a defect could not, under the law, be relied upon as establishing a constructive reduction to practice because there was no sworn support for the altered application.

From the foregoing, it seems clear that appellants must have taken the statement from Rivise & Caesar out of con-

text as the authors apparently intended only to cover the area of law which was more fully developed in *Vandenberg*, supra.

The dispositive issue here for decision is *priority of inventorship*. It is not whether appellee's parent application would result in a valid patent if prosecuted to final allowance.

In the instant case, priority of inventorship was awarded to Olin by the board because it found that Olin was the first to conceive the invention and file an application on it with no argument to the contrary. Priority thus was determined on the basis of Olin's first conception plus his first constructive reduction to practice. This clearly is an adequate basis upon which to make a valid award of priority.

I do not question the authorities cited by the majority. It seems to me, however, that this appeal presents questions of patent law which are broader in scope than the majority opinion has chosen to deal with, hence my concurrence. I would predicate affirmance of the appealed decision on the failure of the arguments advanced by appellants in showing why appellee's parent application was so "incomplete" as to be insufficient as a matter of law.

APPENDIX III

Decision of Board of Patent Interferences, October 10, 1963

The common invention at issue is aptly illustrated by the following single count:

Count 1

A process which comprises reacting 2,2,2-trifluoroethyl p-toluene sulfonate with an alkali metal 2,2,2-trifluoroethanolate and obtaining 2,2,2,2′,2′,2′-hexafluorodiethyl ether as a product therefrom.

Krantz *et al.* disclose their ether to be useful as a convulsive shock agent in the treatment of mental illness. Olin's disclosure is that his ether has useful solvent properties; that it may be used to prepare pastes or dispersions of high molecular weight fluorine compounds such as fluorocarbon waxes; that it may be used to soften or solubilize polymeric materials, e.g., synthetic materials; and that it is chemically reactive and may be used in the preparation of other fluorinated compounds. The parties properly recognized that the difference in objectives is immaterial since they have made no issue regarding this difference; Davis *et al.* v. Isham *et al.*, 21 CCPA 1222, 71 F. 2d 204, 1934 C.D. 574, 21 USPQ 630; Wemple *et al.*, v. Pierce *et al.*, 22 CCPA 1064, 75 F. 2d 998, 1935 C.D. 428, 25 USPQ 37; Becket v. Arness, 27 CCPA 1251, 112 F. 2d 1011, 1940 C.D. 589, 46 USPQ 48.

The count, which originated in the Krantz *et al.* application where it appears as original claim 15, was suggested by the Examiner to Olin for the purpose of contesting priority. When Olin made the claim in his involved application the interference was declared.

An application of Krantz *et al.* filed May 7, 1957, is in interference with an application of Olin filed June 20, 1960. Olin is senior party because in declaring the interference the Examiner accorded him the benefit of the filing date of

December 29, 1955, of his earlier filed copending application. This last mentioned date is not in dispute here.

The Krantz *et al.* application is assigned to Air Reduction Company Incorporated, of New York, while Pennsalt Chemicals Corporation, of Pennsylvania, is the assignee of the Olin applications. These are the real parties in interest.

Krantz *et al.*, the junior party, have the burden of establishing priority by a preponderance of the evidence.

The parties filed a stipulation of facts and stipulated testimony in lieu of taking of testimony. They also filed briefs and were represented at final hearing.

According to the stipulation of facts it was stipulated by the parties that Olin performed the steps of the process of the count in May, 1955 and identified the product of that process to be bis-trifluoroethyl ether on July 28, 1955; and that Krantz *et al.* performed the steps of the process of the count in November, 1955, and identified the product of that process to be hexafluorodiethyl ether on November 30, 1955. The parties also stipulated that the two names, inter alia, identify the same product of the process of the count.

Because of the aforementioned stipulations Olin argues that he reduced to practice in May, 1955, and cites In re Wilkie *et al.*, 50 CCPA 964, 314 F. 2d 538, 793 O. G. 394, 136 USPQ 435, as support for his position.

The heart of Krantz *et al's* case is that (main brief, page 30):

> The claim which represents the count in issue is not adequately supported by the Olin application. The process defined by this claim never was actually or constructively reduced to practice by Olin for the reason that Olin never discovered, nor did he adequately

disclose, any bona-fide use or utiltiy for the process defined by the said count.

The foregoing is evidently based on pages 5 to 6 of the stipulation of facts; the stipulated deposition of Olin, pages 39 to 41; and the stipulated affidavits of Neeley, pages 51 to 53, which are based on the ex parte tests conducted by Speers as set forth in stipulated Krantz *et al.* Exhibit 7; and of Wamser, pages 55 to 60. This evidence, briefly summarized, is that neither Olin nor any agent acting in his behalf ever tested the ether produced by the process of the count for his disclosed uses; that that ether does not possess in part the utilities described for it in the involved Olin application; and that the ether is toxic to humans in small amounts which fact is not disclosed in the involved Olin disclosure.

It may be noted that the involved Olin application is stated to be a continuation of the Olin parent application which, as pointed out above, has been accepted by the Examiner. Consequently, the same charges made against the involved Olin application run to the parent application. Since the two are substantial duplicates we will confiine our remarks to the involved Olin case.

Turning now to Olin's case for a reduction to practice based on the In re Wilkie *et al.*, case, it is our opinion that the decided case is restricted to the proving of a constructive reduction to practice only. We are confirmed in this view of the case by the Court's opinion in In re Nelson *et al.*, 47 CCPA 1033, 280 F. 2d 172, 758 O. G. 233, 126 U.S.P.Q. 242, 255, where the court drew a distinction between a constructive reduction to practice and testing required to establish utility in inter parties priority disputes. In the Nelson *et al.* case, the Court refused to extend the holding thereof to a case where testing may be required in an inter partes priority case (interference) to establish utility because the decided case was an ex

parte case. In short, In re Wilkie *et al.* cannot be relied upon, in this case, to prove an actual reduction to practice merely because the steps of the count were carried out.

The law governing the proving of an actual reduction to practice of a process is set forth in Birmingham v. Randall, 36 CCPA 780, 171 F. 2d 957, 620 O. G. 683, 80 USPQ 371, 372. There the Court said:

> The invention in issue is a method of making a product. We have repeatedly held that such an invention is not reduced to practice until it is established that the product made by the process is satisfactory, and that this may require successful testing of the product. (citing decisions).

The testing of the product, as set forth in the Birmingham case, supra, is required to demonstrate the utility thereof is amply borne out by the record. The stipulated affidavit of Neeley (Rec., page 50) states that to the best of his knowledge the ether "has never been known and prepared or any method for its preparation disclosed" prior to the filing of the parties' involved application; and that he is aware of no practical or effective use of the ether other than as a convulsant as disclosed by Krantz *et al.* In this connection, page 6 of the Krantz *et al.* main brief states that both parties concede that the ether of the process of the count has never been synthesized prior to the filing of the parties' involved applications.

On the other side of the picture, there is the Examiner's position that the product is shown to be old in Henne *et al.*, *Jour. Am. Chem. Soc.*, Vol. 72 (1950), pages 4378 to 4380. In the Examiner's answer to an appeal in the parent Olin application from the final rejection of Claim 1 drawn to the ether per se on this Henne *et al.* article, the Examiner held that:

> Here Henne *et al.* name this specific ether as exemplary of a class of beta-fluorinated compounds,

although they do not disclose if or how this specific ether is prepared.

There is also in the record of the earlier Olin application an affidavit by Dr. Henne that the ether of the article was hypothesized, that it was a non-existent compound at that time and that Mr. Smook, co-author of the article in question, unsuccessfully tried to prepare the ether.

Neeley's affidavit, supra, takes on added significance, as regards proving actual reduction to practice, when it is considered that the Henne *et al.* article does not describe any uses. But Olin has placed in evidence three patents—Benning *et al.*, Pat. No. 2,336,921; McBee *et al.*, Pat. No. 2,452,944; and Simons, Pat. No. 2,500,388—to show that because the ether in question has obvious structural similarity to the patented compounds then one skilled in the art would expect the instant ether to be useful at least as a solvent as are the patented compounds.

It is clear to us that the ether produced by the process of the count is of such a nature that tests would be necessary to determine whether or not it was satisfactory. The ether is asserted by the parties to be new—there is a dispute between the parties and the Examiner as to this—and there is no evidence adduced, other than the involved applications, which describes the compound by giving a use or uses, for example. It is evident that, while the solvent properties of the ether might be reasonably deduced from its similarity to the known patented compounds, supra, they could not be foretold with certainty. In this connection, the parties subjected their compounds to tests and Speers (Rec., page 16, Krantz Exhs. 7, Tab 12 and VF, Tab 25; the Neeley and Wamser affidavits, Appendices IV and V) made extensive solvency tests. Blicke v. Treves, 44 CCPA 753, 241 F. 2d 718, 717 O. G. 215, 112 USPQ 472, 475; Gallagher v. Hien, 25 App. D. C. 77, 1905 C. D. 624, 628. For these reasons, the instant ether is not of such a nature that it is reduced to practice merely by making it.

Testing to demonstrate utility of the compound is necessary to prove an actual reduction to practice; Birmingham v. Randall, supra.

Since Olin has stipulated (1) that the pharmacological testing of the ether by Latven was unsuccessful, and (2) that no further tests were conducted by or on behalf of himself, Olin has not proved an actual reduction to practice.

This brings us to the parent application. As pointed out above, Krantz *et al's.* attack on the involved Olin application runs to the parent Olin application as well. We cannot agree with Krantz *et al's.* position that the subject matter of the Olin applications is dangerous to the public and for that reason cannot serve as constructive reductions to practice. The record is decidedly to the contrary. It shows that the compound was safely handled while it was being prepared, and used for experimental and testing purposes. See Rec., page 56. It is, therefore, unnecessary to explore this aspect of the case in any great depth. There is of record pages 7 to 23 of The Handbook of Solvents, Scheflan and Jacobs, Tab 29, which are devoted to "Safe Practices in the Use of Solvents." On page 22, examples of labeling "dangerous" solvents, recommended by the Manufacturing Chemists Association, are given. The handbook article shows that a good many solvents are more or less hazardous to use, but this fact alone does not prevent their use.

A similar situation exists in the case of drugs where the question of safety in humans was raised by the Patent Office. The Court of Customs and Patent Appeals has expressed its views regarding this subject. In In re Krimmel, 48 CCPA 1116, 292 F. 2d 948, 773 O. G. 607, 130 USPQ 215, 220, the Court said:

> . . . the fact remains that the Patent Office has not been charged by Congress with the tasks of protecting the public against possible misuse of chemical patents.

And in In re Hartop, 50 CCPA 780, 311 F. 2d 249, 787 O. G. 235, 135 USPQ 419, 428, the Court, after an extended discussion of "safety" reiterated its position as set forth in its earlier decision, In re Krimmel, supra.

In short we fail to find any substance in the "safety" argument pressed by Krantz *et al.*

Nor do we agree with Krantz *et al's.* contention that the Olin applications are not constructive reductions to practice because Olin did not test for any of the utilities set forth in his applications. They contend, therefore, that the Olin applications lack utility.

The difficulty with Krantz *et al's.* position is that Speers, Krantz's co-inventor, did make pastes or dispersions of fluorocarbon waxes as set forth in the Olin Applications; see Rec., pages 51 and 59; Krantz *et al.* Exh. 7. As stated in Robinson On Patents, (1890) Vol. 1, page 464, "When actual utility exists, its degree is unimportant." On page 466 of the same work, "a patent is valid if the invention serves any use though it will not apply to all uses claimed for it;" see Phillips v. Risser (1885), 26 F. R. 308. In Landon v. Ginzton et al., 41 CCPA 950, 214 F. 2d 160, 688 O.G. 213, 102 USPQ 230, 233, the Court said:

> The patent application may reveal a number of purposes for the same invention. The inventor need prove only one practical use; only one useful result or effect.

This excerpt from the Landon case was quoted with approval in Conner v. Joris, 44 CCPA 772, 241 F. 2d 944, 717 O.G. 415, 113 USPQ 56, 58, 59. See also Friedman v. Overseas Scientific Corporation *et al.* (CA-2), 248 F. 2d 274, 115 USPQ 42, 44, wherein it was held:

> An article invented may have patentable utility even though the patented device is not unfailingly operable in all its applications. Hildredth v. Mastoras, 257 U. S. 27.

Since there is proof of one of the disclosed utilities, it is unnecessary to reach the other uses set forth in the Olin specification.

Krantz *et al.* also contend that the Olin applications should contain a warning of the danger to people of the ether. We are not impressed by this argument. The specification is addressed to persons skilled in the art. Moreover, the "safety" aspect of the case has been discussed above and need not be repeated.

Krantz *et al's.* contention that the Olin applications are not constructive reductions to practice because Olin "guessed" at the disclosed utilities must be rejected. The answer to this argument is supplied by the case Automatic Weighing Machine Co. v. Pneumatic Scale Corp. Ltd. (CCA-1), 166 Fed. Rep. 288, 1909 C.D. 498, 506, 507. The Court, in that case, referred to the Supreme Court holding in the Telephone Cases, 126 U. S. 1,535, 1888 C. D. 321. There, when Bell applied for his patent he had never actually transmitted, telegraphically, spoken words so that they could be distinctly heard and understood at the receiving end of his line. But in his specification he described with sufficient precision to enable one of ordinary skill in such matters to make an apparatus, which, if used in the way pointed out, would produce the required effect, receive the words, and carry them to and deliver them at the appointed place.

The Supreme Court said in that case:

> The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of profection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation.

Clearly, Olin has complied with the law as set forth in the foregoing excerpt. The record shows that Speers produced pastes and solutions of fluorocarbon waxes, as pointed out above. Therefore, it is our view that the Olin cases are complete and allowable applications and that Olin is entitled to the filing date of his parent application, namely, December 29, 1955, for a constructive reduction to practice of the count; the Automatic Weighing Machine case, supra.

Adverting to the case for Krantz *et al.* it is noted that they do not rely on diligence so that it is unnecessary to consider this issue as well as conception. Krantz et al. can prevail only if they can prove an actual reduction to practice prior to Olin's effective filing date.

All of Krantz *et al's.* proofs for an actual reduction to practice are subsequent to the Olin effective filing date. For example, the Krantz *et al.* main brief, at pages 12, 21 and 31, admits that their testing as an inhalation anesthetic was unsuccessful. Krantz *et al.* Exhibit 3, dated January 30, 1956 Tab 5, is the evidence upon which the admission is based and is evidence of the earliest testing by Krantz *et al.* There is, therefore, no need, in the absence of diligence, to inquire into the subsequent work of Krantz *et al.* Manifestly, on this record, Krantz *et al.* cannot prevail. Olin is the first to conceive and the first to reduce to practice by virtue of the filing of his parent application. Olin is, therefore, entitled to the award of priority.

Rule 255 makes it discretionary with us to accept or reject Krantz *et al's.* proposed findings of fact and conclusions of law (Reply Brief, pages 20 to 22). Because of our detailed treatment of the various issues advanced no need is seen to specifically consider the proposed findings and conclusions of law.

Priority of the subject matter in issue is hereby awarded to John F. Olin, the senior party.

BOARD OF PATENT INTERFERENCES

WARREN H. WILLNER
Examiner of Interferences

S. LEVIN
Examiner of Interferences

GEORGE W. BOYS
Examiner of Interferences

APPENDIX IV

Order

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Thursday, March 10, 1966

At a session of said court continued and held at the city of Washington, pursuant to adjournment, on this 10th day of March, A. D. 1966.

Present the Honorable Eugene Worley, Chief Judge, and the Honorables Giles S. Rich, I. Jack Martin, Arthur M. Smith and J. Lindsay Almond, Jr., *Associate Judges.*

The court was opened for business in due form.

* * * * * * * * * * *

Patent Appeal No. 7415

JOHN C. KRANTZ, JR. and LOUISE SPEERS CROIX, *Appellants,*

v.

JOHN F. OLIN, *Appellee.*

Said appeal having heretofore been brought on to be heard before the court and due consideration thereon having been had, it is—

ORDERED that the decision of the Board of Patent Interferences be, and the same is hereby, affirmed. Opinion by Rich, Associate Judge. Chief Judge Worley concurs in the result. Concurring opinion by Judge Smith with whom Judge Martin joins.

* * * * * * * * * * *

APPENDIX V

Petition of Krantz and Croix for Rehearing

FOREWORD

This case was decided by this Court on March 10, 1966.*

Eleven days later, on March 21, 1966, the Supreme Court of the United States decided the case of *Brenner* v. *Manson*, — U.S. —, 148 U.S.P.Q. 689, reversing a decision of this Court** on writ of certiorari.

Believing the now applicable case law with respect to utility of a chemical process as laid down by the Supreme Court in *Brenner* v. *Manson, supra,* to be contrary to the law that had been applied to the present case at the time of its argument and decision, appellants, Krantz and Croix, moved on March 31, 1966 for an extension of time to file a petition for rehearing in this Court. Such motion was granted by this Court and the time for filing this petition was extended to May 3, 1966. Accordingly, this petition is timely filed.

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* Rich, J.'s opinion for the Court is reported at 148 U.S.P.Q. 659, — F. 2d —, 53 C.C.P.A. —; Worley, C. J., concurred in the result; Smith, J. concurred specially in an opinion reported at 148 U.S.P.Q. 663, — F. 2d —, 53 C.C.P.A. —, in which Martin, J. joined.

** *In re Manson,* 142 U.S.P.Q. 35, 333 F. 2d 234, 52 C.C.P.A. 739 (1964).

THE BASIS OF THIS PETITION

It now appears (in view of the Supreme Court decision in the *Manson* case) that a mistake of law was involved in the original hearing of this cause.

At the time of argument of the present case before this Court, the prior decision of this Court in *In re Manson, supra,* was controlling law on the requirements for utility of the product of a patentable process claim. The Supreme Court had not yet spoken on the merits of that issue involved in the *Manson* case. There was even a question as to whether it would so speak because never before had there been an instance where the Supreme Court had taken and decided any patent case on writ of certiorari to the Court of Customs and Patent Appeals.

Therefore Krantz's attack on the "utility" disclosure in the Olin application necessarily was severely circumscribed, as compared to what it could have been had the applicable constitutional provisions, patent statutes and Patent Office regulations been interpreted as they have since been interpreted by the Supreme Court in its decision in the *Manson* case.

Thus, Olin was at the time of argument of this cause in a position to state, without fear of effective rebuttal by Krantz, what now clearly appears to have been a mistake of law although not so recognized at the time:

> "The statements of this Court [the C.C.P.A.] in the case of *In re Manson* make it clear beyond question that whatever may have been the case previously, it is no longer required by this Court that a patent specification describe uses for the product of a claimed method in order to support properly claims to the method."

and:

> ". . . Appellant's challenge is directed not to a requirement going vitally to the adequacy of the application

but rather to a gratuitous statement that could have been entirely omitted without affecting in the least the adequacy of the application to support the method claim in contest."

The above are quotations from Olin's brief on appeal to this Court, page 5.

It is respectfully submitted that in order to correct this error, or at least to afford Krantz an adequate opportunity to be heard thereon, this Court should rehear and reconsider this case in the light of the decision by the Supreme Court overruling the decision of this Court in the *Manson* case. Whatever the ultimate wisdom of the higher Court's decision in the *Manson* case may turn out to be, it does represent the law of the land and Krantz is believed entitled, in fairness, to have his claim of right to the claim here in issue adjudicated on the basis of the law as it exists and not solely on the basis of what the parties involved mistakenly thought it to be.

Reasons Why This Petition Should Be Granted

The primary, and "private," reason for granting this petition is that a rehearing is necessary, in the submission of Krantz, in order that both parties can be heard on the question of what effect, if any, the action of the Supreme Court in overruling this Court's decision in the *Manson* case has on this Court's decision in the present case. In this connection it should be noted that the ruling of the Court in the present case is not yet final. The time prescribed by its Rule VII for granting a rehearing has not yet expired.

A secondary, and "public," reason for rehearing this cause is that prompt application and further interpretation of the Supreme Court's decision in the *Manson* case is believed in the public interest. The law pertaining to disclosure of utility in patent applications has undergone a

change in recent years. It appears that further changes will now be necessary. The more promptly the pending questions are settled in appropriate cases (and the present case is believed to be an appropriate case), the less likely the possibility that future mistakes may accur in the filing of patent applications or the issuance of patents thereon involving questions of utility for the product of a chemical process.

Questions Presented

I. *Re Utility:* Does the patent application of the party Olin meet the standard of utility for a claim directed to a new chemical process, and the standards of disclosure of utility for such a process claim, announced by the Supreme Court in the *Manson* case?

II. *Re "Making" an Invention:* If neither the patent application nor the pre-application work of the party Olin meets the standards of utility and the standards of disclosure of utility required under the doctrine of the *Manson* case, then can Olin properly be awarded a date for "making" the invention of the process claim in issue on the basis either of having filed his application or his work?

III. *Re Remand of the Case to the Patent Office:* Should this interference, particularly the sufficiency of the Olin position, be remanded to the Patent Office for reconsideration in the light of the Supreme Court ruling in the *Manson* case?

Argument

Question I: Re Utility: *Does the patent application of the party Olin meet the standard of utility for a claim directed to a new chemical process, and the standards of disclosure of utility for such a process claim, announced by the Supreme Court in the* Manson *case?*

Petitioners contend that it is now the law in the United States that a "*substantial*,"* "*practical*,"** and "*specific*"*** utility for the product of a chemical process is prerequisite to the patentability of such process. At least in those instances where such a utility was not previously known and disclosed in the prior art, an applicant for patent directed to a chemical process must, in order to have a sufficient and adequate application, include a sufficient and adequate showing or teaching therein of such a substantial, practical, and specific utility.

It follows, contrary to the statements made in Olin's brief on appeal, that the utility prerequisite (and disclosure thereof) *does* go vitally to the adequacy of the Olin application and that Olin's statement of utility *cannot* be regarded as a "gratuitous statement that could have been entirely omitted without affecting in the least the adequacy of the application to support the method claim in contest."

Rather, Olin's statement of utility must, in order to determine if the Olin specification (or the Olin work) is sufficient and adequate to support the process claim in issue,

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* "The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with *substantial* utility." [Emphasis added.] 148 U.S.P.Q. 695.

** "This case presents two questions of importance to the administration of the patent laws: * * * second, whether the *practical* utility of the compound produced by a chemical process is an essential element in establishing a prima facie case for the patentability of the process." [Emphasis added.] 148 U.S.P.Q. 690.

*** "* * * a more compelling consideration is that a process patent in the chemical field, which has not been developed and pointed to a degree of *specific* utility, creates a monopoly of knowledge which should be granted only if clearly commanded by statute. * * * Unless and until a process is refined and developed to this point—where *specific* benefit exists in currently available form—there is insufficient justification to engross what may prove to be a broad field." [Emphasis added.] 148 U.S.P.Q. 695.

be examined and considered to determine if either was, within the meaning of the *Manson* case, substantial, practical, and specific as opposed to insignificant, speculative, and merely general.

When so examined and considered in the light of the *Manson* case, it becomes clear that Olin's "utility" and the disclosure thereof in the Olin application was neither substantial, nor practical, nor specific. The record in this interference shows by uncontroverted evidence:

(a) That Olin was searching for a new anesthetic. He *tested* the product of the process defined by the interference count *only* for this use and such tests *failed* R-173-175; App. I*).

(b) That the statements of use in the Olin application were pure guesses or speculation, even though positively recited (R-173-175; App. I).

(c) That the uses alleged in the Olin application are impractical as shown by the affidavits of Krantz's experts, Wamser, and Neeley (R-182-186, 178-182; Excerpts reproduced in App. II). Olin not only has failed to controvert these affidavits, but, in fact, accepted them by relying thereon in an attempt to support his own case (Olin Brief, p. 7).

(d) That there is no evidence of record in this interference showing or tending to show that the uses stated in the Olin application are in reality substantial or practical uses (R-149; App. III).

(e) That the uses stated in the Olin application are obviously and on their face vague and incomplete. Olin's "use" disclosures were not carried to the point wherein they properly could be regarded as "specific"

* For the convenience of the Court the three passages from the Record particularly relied upon to support this petition which appellants wish the Court to re-read are reproduced as Appendices I, II, and III, at the end of this petition.

uses within the meaning of the *Manson* case. In fact, the experts Wamser and Neeley stated that in their opinion fluorocarbon pastes or dispersions made with hexafluorodiethyl ether would have no practical utility (R-186, 180; App. II). Their testimony with respect to those fibers that could be softened with hexafluorodiethyl is to the same effect (ibid.). And they testified, contrary to Olin's "guess," that the compound was "chemically stable" rather than being "chemically reactive" (Ibid.). In the face of the testimony by Wamser and Neeley as to the stability of the compound, Olin's vague statement to the effect that hexafluorodiethyl ether "may be used in the preparation of other fluorinated compounds" could be no more than an invitation to do research. It is not statement of a specific utility. The Supreme Court in the *Manson* case expressly considered and denied the contention that such "potential usefulness" is enough. Rather it held that a patent is to be regarded not as a reward for the search, but as compensation for its successful conclusion.

Appellants recognize that many, if not all, liquids have sovlent properties to some degree and that many, if not all, compounds can be caused to react to form other compounds. Thus in a very broad sense it could be said that Olin's speculation to the effect that his new compound has these properties can be considered true. In fact, Krantz's experts, Wamser and Neeley, did show by test that the product of the count does have some solvent properties. And Krantz does not deny that any compound or element can be reacted if the reaction conditions are sufficiently stringent. But such theoretical or academic "utility" is a far cry from the substantial, practical, and specific use that, appellants submit, is required under the legal principles applied by the Supreme Court in the *Manson* case. When the record of this case is viewed as a whole, as it should be, it becomes very clear that Olin did not

press his search to a successful conclusion. He did carry out the process and produce the compound. So did Manson. But, when Olin tested his compound for the only practical use he had intended (as an anesthetic), it failed in the very first phase of testing (the initial experiments on mice). Having failed in his search for an anesthetic Olin stopped all work and turned to the Patent Office in an attempt to reap the reward for his search by filing a patent application.

Appellants submit that what Olin actually did was to substitute a so-called "spurious" or "makeweight" use* in the disclosure of his patent application for the originally intended actual use which he had tested and found unsuccessful. To permit "spurious" or "makeweight" uses to suffice for the requirement of utility obviously would be quite helpful to patentees if permitted, but this clearly would not be in accord with the constitutional and legislative purposes of the patent system as interpreted by the Supreme Court in the *Manson* case. What Olin did is contrary to the doctrine the Supreme Court has laid down in the *Manson* case. Consequently, this Court should now hold that Olin's application does not meet the minimum applicable *prima facie* standards of utility and disclosure thereof as required by the *Manson* case.

QUESTION II: RE "MAKING" AN INVENTION: *If neither the patent application nor the pre-application work of the party Olin meets the standards of utility and the standards of disclosure of utility required under the doctrine of the* MANSON *case, then can Olin properly be awarded a date for "making" the invention of the process claim in issue on the basis either of having filed his application or his work?*

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* Any new compound having significant mass has such a "spurious" use as a paperweight; any new liquid is almost sure to be a solvent for something. While such "utility" may meet the now-rejected "Story test" for utility, that test has been expressly repudiated by the *Manson* decision.

The legal question raised in this interference proceeding is one of priority of invention. This question in turn depends on the issue of whether or not Olin ever did "make" the "invention" which is the subject of the interference and, if so, whether or not he did so before Krantz. Because Krantz beyond doubt did "make" the inevtion and Olin has never denied this.

Olin did not contend in the course of the original hearing that he ever "made" the invention by way of an actual reduction to practice. It is believed he made no such contention because he apparently accepted the fact that his only test for utility had failed (See Appendices I, II, and III). The decision of the Supreme Court in the *Manson* case makes it clear that Olin's concession in this respect was correct.

Olin did, however, contend that he had "made" the invention by the filing of his patent application, in which utilities were alleged other than the one for which he had tested and found to be non-existent. But the speculative uses so alleged in his patent application were in fact no more than "spurious" or "makeweight" uses. They clearly are not the substantial, practical and specific uses now believed to be required by the tests of the *Manson* case, as decided by the Supreme Court. Consequently, such spurious utility must, it is contended, be regarded as legally ineffective and as little or no better than nothing at all. In the opinion of Krantz, such uses are even worse than nothing at all because they are considered misleading for the reasons pointed out by Krantz in his original argument of this cause. See *In re Citron,* 139 U.S.P.Q. 516, 325 F. 2d 248, 51 C.C.P.A. 852 (1963) and *In re Citron,* 139 U.S.P.Q. 520, 325 F. 2d 254, 51 C.C.P.A. 859 (1963).

And this insufficiency and inadequacy of the Olin "use" disclosures is considered clearly to be ancillary to priority in the light of the Supreme Court's ruling in the *Manson* case. If no utility for the product is actually known (as

was the situation with Olin in the present case), and if a substantial, practical, and specific utility must be either known or be shown (as is believed to be required by the Supreme Court's ruling in *Manson*), then Olin in order to provide a sufficient disclosure to support his process claim was *required* to disclose its product "in such full, clear, concise and exact terms as to enable any person skilled in the art * * * to make *and use* the same." 35 U.S.C. § 112 [Emphasis added]. Having failed to do so, within the meaning of the "substantial," "practical," and "specific" tests laid down by the Supreme Court, Olin cannot properly be said to have made or completel his invention either by reason of his unsuccessful test for a non-existent utility or by the filing of his patent application reciting insignificant, impractical, and vaguely generalized speculations as to usefulness.

QUESTION III: RE. REMAND OF THE CASE TO THE PATENT OFFICE: *Should this interference, particularly the sufficiency of the Olin position, be remanded to the Patent Office for reconsideration in the light of the Supreme Court ruling in the* MANSON *case?*

It has occurred to Appellants that this Court may, in the event rehearing is granted, desire first to have the Patent Office reconsider the sufficiency of Olin's "use" disclosures, either with or without the benefit of further testimony, in the light of the new requisites for utility announced by the Supreme Court in *Manson*. No objection will be made on the part of the party Krantz to any such remand if this Court, or the party Olin subject to approval of this Court, may find that a remand for such purpose would be helpful to the proper disposition of this cause.

We are mindful that the Supreme Court has recently suggested that public issues of importance should not be decided on stipulated records made before full and correct appreciation of the legal issues involved, *Public Affairs Associates, Inc.* v. *Rickover*, 365 U.S. 841 (1962), and has

even more recently indicated the propriety of remand on the Customs side of the work of this Court, *Clayton Chemical and Packaging Co.* v. *United States*, — U.S. — (March 28, 1966).

Conclusion

It is respectfully submitted that this Court should re-examine its ruling as to the showing of utility made on behalf of the Olin application here in issue and to that end grant a rehearing in order to have the benefit of the argument of counsel with respect to the applicability to that ruling of the new *Manson* standards of utility.

This Petition of Krantz and Croix for Rehearing should be Granted.

APPENDICES TO PETITION FOR REHEARING

Appendix I: (R-173-175.) From Deposition of John F. Olin:

"Q1. When you succeeded in preparing bis trifluoroethyl ether, what uses were obvious to you, based on its chemical structure and physical properties?

"A. It was expected that bis trifluoroethyl ether would be an anesthetic of low toxicity and flammability.

"Q2a. Did you expect bis trifluoroethyl ether to have any utility other than those in question 1?

"b. If so, what?

"A. Because of superficial similarity to the 'Freons' it was thought that bis trifluoroethyl ether might have use as a general solvent and specifically as an aerosol propellant composition.

"Q3. In your patent application you disclose that bis trifluoroethyl ether has useful solvent properties. Specifically, you state that it 'may be used to prepare

pastes or dispersions of high molecular weight fluorine compounds such as fluorocarbon waxes.'

"a. Did you ever prepare any pastes or dispersions in which bis trifluoroethyl ether was used as the dispersing medium.

"b. If so, what? and

"c. When?

"A. No.

"Q4. You also disclose in your patent application that bis trifluoroethyl ether may be used to soften or solubilize polymeric materials, e.g., synthetic fibers.

"a. Did you ever use bis trifluoroethyl ether to solubilize a synthetic material?

"b. If so, what synthetic material? and

"c. When?

"A. No.

"Q5. Did you ever test bis trifluoroethyl ether as a solvent for any material?

"a. If so, what? and

"b. When?

"A. No.

"Q6. You also disclose in your patent application that bis trifluoroethyl ether is chemically reactive and may be used in the preparation of other fluorinated compounds.

"a. Did you ever chemically react bis trifluoroethyl ether with another material?

"b. Did you ever prepare another fluorinated compound from bis trifluoroethyl ether?

"c. If so in either (a) or (b), state what and when.

"A. No.

"Q7. Do you know of any use for which bis trifluoroethyl ether is presently being used?

"A. Mr. Lyden informed me via telephone on October 10, 1962 that bis trifluoroethyl ether was of value in treatment of mental disorders. Aside from this I know of no present use.

"Q8a. Do you know of any records, such as your personal notes, where a proposed utility or an actual utility for bis trifluoroethyl ether is recorded?

"b. If so, where are these records? and

"c. When was the record made?

"A. All communications recording proposed utility were verbal.

"Q9a. Do you recall any conversations with anyone as to the utility of bis trifluoroethyl ether before or after the compound was prepared?

"b. If so, with whom? and

"c. When?

"A. Conversations with W. A. LaLande, Jr., indicated that contrary to expectations, bis trifluoroethyl ether was quite toxic and, hence, not suitable for anesthetic purposes (August 1955)."

APPENDIX II: (R-180.) FROM THE AFFIDAVIT OF ARTHUR H. NEELEY:

"To the best of my knowledge, hexafluorodiethyl ether is a novel compound, at least to the extent that it has never been known and prepared or any method for its preparation disclosed, prior to the above-mentioned Krantz and Croix application and the

applications of John F. Olin. I am aware of no practical or effective use for hexafluorodiethyl ether other than its use as a convulsant as disclosed in the Krantz and Croix application.

"On the basis of the extensive pharmacological and clinical investigations of hexafluorodiethyl ether with which I have been directly involved, it is my opinion that hexafluorodiethyl ether has no practical utility for any of the purposes alleged in the above-identified John F. Olin application because of its extreme stability and because of its potency as a convulsant."

(R.-186.) From the Affidavit of Christian A. Wamser:

"Based upo nthe extensive chemical investigation with hexafluorodiethyl ether with which I have been directly involved, including those tests referred to above, it is my opinion that the disclosure of the Olin applications affords no basis on which anyone skilled in the art could make any practical use of the compound hexafluorodiethyl ether.

"It would not be possible, in the light of the unusual properties of this material to predict or anticipate, on the basis of the John F. Olin disclosures, what fluorinated compounds might be prepared from hexafluorodiethyl ether or in what manner this compound could be treated to produce another product.

"Similarly, the disclosure, with respect to the solvent properties of hexafluorodiethyl ether, would be insufficient to enable use of hexafluorodiethyl ether for this purpose without prior research investigations, particularly in the absence of a disclosure of the extreme potency of this material as a convulsant."

Appendix III: (R-149.) From Stipulation of Facts:

"IV. As of the present date the only tests or investigations of the compound known as hexafluorodi-

ethyl ether conducted by the party Olin or by an agent acting on his behalf constitute the experimental work on mice made by Albert R. Latven. The results of these tests were reported by Albert R. Latven in letters dated August 18, 1955 and June 18, 1958, and reports attached thereto identified elsewhere as Olin Exhibit P and Latven Exhibit 4, respectively."

APPENDIX VI

Olin Exhibit P

Interference No. 91,447

August 9, 1955

Mr. N. D. Peschko
Pennsylvania Salt Manufacturing Company
Research and Development Division
Box 4388 Chestnut Hill P. O.
Philadelphia 18, Pa.

Re: NP—2077, Anesthetic Screen

Dear Mr. Peschko:

This is to confirm our phone conversation yesterday in reference to preliminary studies concerning "inhalation anesthetic activity" of NP-2077. Mice were used as the experimental animal, exposed to several concentrations of vapor in a sealed 20 liter chamber.

Effects were dramatic. Within 20 seconds, violent clonic convulsions appeared, terminating in an intense strychnine-like tonic spasm; relaxtion from the tonic spasm then followed accompanied by loss of the righting reflex for the remainder of the enclosure period. During the latter interval, continuous asymetric convulsive contractions of the legs and body were present; muscular relaxation was never evident. Progressive cyanosis terminated in respiratory failure and death following which rigor mortis appeared quite rapidly.

The foregoing effects were produced by extremely low concentrations of NP-2077:

0.0051 cc/l: severe muscular spasms, recovery.
0.0103 cc/l: occasional convulsions, recovery after 30 minutes exposure.

0.025 cc/l Above syndrone, death in 6 minutes in one instance, and several after a 30 minutes exposure in another.

0.077 cc/l above syndrone, all 5 mice dead between 2 and 5 minutes.

For comparative purposes, it may be pointed out that ethyl ether does not produce anethesia within 30 minutes at 0.15 cc/l, but does induce anethesia within that period of time at 0.20 cc/l.

Thus it is apparent that this compound is extremely toxic and is absorbed systemically within seconds following inhalation. WE URGE YOU TO TAKE EVERY PRECAUTION IN HANDLING THIS MATERIAL AND TO AVOID ACCIDENTAL INHALATION AT ALL COSTS. You can imagine what might happen if the glass container were accidentally dropped and broken on the laboratory floor.

Sincerely yours,

PHARMACOLOGY RESEARCH, INC.

A. R. LATVEN
Albert R. Latven

RPS/dir. dict.